



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DAE #4

Inventors: Seong Min Seo, Young Suk Chung, Jon Sik Paek, Jae Hun Ku, Jae Hak Yee  
Assignee: Amkor Technology, Inc.  
Title: Semiconductor Package Including Stacked Chips  
Serial No.: 09/816,599 Filing Date: March 23, 2001  
Examiner: Not Yet Assigned Group Art Unit: 2811  
Docket No.: AB-1111 US

San Jose, California

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

DECLARATION OF JAMES E. PARSONS IN SUPPORT OF PETITION  
FOR FILING BY OTHER THAN ALL INVENTORS (37 C.F.R. 1.47(A))

I, James E. Parsons, declare as follows.

1. I am a registered U.S. patent attorney (no. 34,691) and an attorney of record on this application. My office is at Skjerven Morrill MacPherson LLP, 25 Metro Drive, Suite 700, San Jose, California, 95110 (phone (408) 453-9200).

2. Joint inventors Jae Hun Ku and Jae Hak Yee are and have been unwilling to participate in the present application. I have made efforts to obtain their participation, as I will discuss further below, but these efforts have not been successful.

3. I was informed that Messrs. Ku and Yee were formerly employed by Anam Semiconductor Inc. ("Anam"). Assets of Anam, including the present invention, were acquired by assignee Amkor Technology, Inc. ("Amkor") on May 1, 2000. Mr. Yee resigned from Anam on December 28, 1999 and Mr. Ku resigned from Amkor Technology Korea, Inc. on October 25, 2000.

4. I am informed and believe that Messrs. Ku and Yee joined a competitor to Amkor, namely, ST Assembly Test Services, Inc. of Singapore ("STATS"). Amkor and STATS compete in the same semiconductor industry sector, namely, semiconductor

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packaging, assembly, and testing. In addition to being business competitors, Amkor and STATS have legal disputes between them in both the U.S. and Singapore.

5. According to communications from STATS' attorneys, Amkor and its attorneys are not to directly communicate with former employee/inventors of Anam or Amkor who are now in the employ of STATS. Rather, all communications with the former employee/inventors are to go through STATS' attorneys, i.e., the Drew & Napier law firm of Singapore. The relevant attorneys are:

Davinder Singh, Esq. and Jupiter Kong, Esq.  
Drew & Napier  
20 Raffles Place  
#17-00 Ocean Towers  
Singapore 048620

6. As mentioned above, I have made efforts, all unsuccessful, at obtaining the participation of Messrs. Ku and Yee in the present application. In particular, I engaged Axel Chan of the law firm of John, Tan & Chan of Singapore to contact Messrs. Ku and Yee through the Drew & Napier firm. At my instruction, Mr. Chan sent a letter to Drew & Napier on April 16, 2001 requesting that Messrs. Ku and Yee review the application and sign the inventor declaration for this application. A copy of Mr. Chan's letter is attached hereto as Exhibit A. A reminder letter was sent by Mr. Chan on May 18, 2001. Drew & Napier wrote back on May 22, 2001 and informed that they would revert back with their clients decision on whether to participate. A copy of the letter from Drew & Napier is attached as Exhibit B. To date, no response has been received. The failure of Messrs. Ku or Yee or STATS attorneys to contact Mr. Chan or Amkor subsequent to May 18, 2001 constitutes an admission that Mr. Ku and Mr. Yee are employed by STATS, and also constitutes a refusal on their parts to participate in the present application.

7. I also am prosecuting three other U.S. patent applications for Amkor, each of which also has an outstanding Notice to File Missing Parts. In each case, the applications were filed without inventor declarations from one or more former employee/inventors of Anam or Amkor who now work for STATS. Mr. Ku is an inventor on three of the four applications, and Mr. Yee is an inventor on two of the four applications. In each of those three cases, Mr. Chan has contacted STATS' counsel to obtain participation of the missing inventors. In no case has Messrs. Ku or Yee or any of the other former employee/inventors come forward to participate. Accordingly, it appears that STATS, Messrs. Ku and Yee, and the other former employee/inventors of Anam or Amkor have made a decision not to

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cooperate in the present application or the three other applications mentioned above, and I expect such non-cooperation will continue absent a change in the relations of Amkor and STATS.

8. I further declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above referenced application or any patent issuing therefrom.

Date:

8/29/01

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